

REMARKS

Applicant has amended claims 1 and 12. Applicant has also amended claims 3, 5, 6, 8-11, 14, and 18-20 to correct minor grammatical errors. Claims 2, 4, 7, 13, and 15-17 were previously cancelled without prejudice. The last paragraph of the section of the Specification entitled Description of the Preferred Embodiments has also been amended. No new matter has been added.

I. REJECTION OF CLAIMS 1, 3, 5, 6, and 8-12 UNDER 35 U.S.C. § 112

Applicant respectfully traverses the Examiner's rejection of claims 1, 3, 5, 6, 8-12, 14, and 18-20 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended claims 1 and 12 of the application to comply with § 112 as requested by the Examiner. Applicant has amended claim 1 to disclose that the user facility includes "at least one breathing air source" for supplying safe air to scuba tanks and emergency air tanks. The main purpose of the invention is to check the quality of breathing air being provided to scuba tanks and emergency air tanks by commercial air suppliers of compressed air. Similarly, claim 12 is amended to disclose that a breathing air sample is collected within a breathing air analysis module from a breathing air source situated at a breathing air producer user facility that provides a source of compressed human breathing air for one or more air collection tanks that collect the samples. Said air collection tanks 25 and 45 are disclosed throughout the specification of the application as well as in Figures 1 and 2 of the drawings.

Applicant also amends claim 12 herein to replace "said breathing air producer user

facility's computer" with "a computer located at said breathing air producer user facility," thereby proper antecedent basis for the computer element of the claim. These amendments to claims 1 and 12 clearly define the metes and bounds of the limitations in said claims. Applicant respectfully requests that the Examiner withdraw these rejections and allow claims 1, 3, 5, 6, 8-12, 14, and 18-20.

II. REJECTION OF CLAIMS UNDER 35 U.S.C. § 102(e)

Applicant respectfully traverses the Examiner's rejection of claims 1, 3, 5, 9, 10-12, 14-16, 18 and 20 under 35 U.S.C. § 102(e) as being anticipated by Banet et al., U.S. Patent No. 6,604,033. Applicant's invention, as expressed in independent amended claims 1 and 12, differs markedly from the invention described by the Banet reference in several aspects.

A. Claims 1, 3, 5, 6, and 8-11

To sustain an anticipation rejection under 35 U.S.C. § 102(e), the Examiner is required to demonstrate "the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick, Co., 730 F.2d 1452, 1458 (Fed. Cir. 1984); see also W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554 (Fed. Cir. 1983). Applicant has amended claim 1 to disclose that the user facility includes one or more air sources that are used to supply air for scuba tanks and emergency air tanks. The Banet patent is directed to a wireless diagnostic system for characterizing a vehicle's exhaust emissions, whereas Applicant's invention is discloses a gas sample analysis system for use with compressed air samples in scuba and emergency air tanks. The Banet patent does not claim or describe a source of breathing air or an air collection tank. Therefore, the

Banet patent does not demonstrate the presence of each and every element of Applicant's claimed invention, arranged as in claim 1.

Moreover, the Banet reference does not disclose "a breathing air sample" and "a breathing air analysis module" as are disclosed by Applicant in claim 1. Rather, the Banet patent describes "at least one sensor disposed in [a] vehicle to generate data representative of [a] vehicle's emissions." See Banet et al. patent, claim 20; see also Banet et al. patent, Figure 5; claims 1, 24, and 32; column 2, lines 49-59; column 3, lines 8-12; and column 8, lines 42-56. Clearly, a vehicle's emissions do not constitute a suitable "breathing air sample" as is contemplated and described by Applicant. Applicant has thoroughly reviewed the Banet reference and is unable to locate any disclosure therein of the vehicle emissions of the Banet invention being used as a breathing air sample containing compressed human breathing air as Applicant describes in his application.

Additionally, Applicant's invention is not anticipated by the Banet reference because the specific subject matters of the Banet patent and Applicant's invention are different. Union Oil Co. of California v. Atlantic Richfield Co., 208 F.3d 989 (Fed. Cir. 2000). As stated above, the Banet patent discloses vehicle emissions and a sensor for generating data representative of those emissions, while Applicant's invention discloses a source of breathing air, a breathing air sample, a breathing air analysis module, and one or more air sample collection tanks. The purpose of Applicant's invention is to save time between the taking of an air sample from a machine that provides compressed air into an air tank that heretofore required mailing the specific sample to a remote laboratory for certification. The process could take weeks.

Finally, dependent claims 3, 5, 6, and 8-11 ultimately depend upon independent claim 1, and thus, incorporate by reference all of the elements and limitations of independent claim 1. 35 U.S.C. § 112, fourth paragraph. This includes the novel feature disclosed in amended claim 1 of a source of air and one or more air collection tanks situated at a user facility for providing compressed human breathing air. As explained above, neither the source of air and the air collection tank of currently amended claim 1 nor the breathing air sample and breathing air analysis module, as construed by reference to Applicant's specification, are disclosed by the Banet patent. Therefore, the Examiner's rejection of Applicant's claims 3, 5, 6, and 8-11 under 35 U.S.C. § 102(e) cannot be sustained. Applicant respectfully requests that the Examiner withdraw this rejection and allow said claims.

B. Claims 12, 14, and 18-20

As with the claims discussed in Section A above, applicant's claim 12 includes, among others, elements described as a source of breathing air, a breathing air sample, a breathing air analysis module, and one or more air collection tanks. To sustain an anticipation rejection under 35 U.S.C. § 102(e), the Examiner is required to demonstrate "the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick, Co., 730 F.2d 1452, 1458 (Fed. Cir. 1984); see also W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554 (Fed. Cir. 1983). Applicant has amended claim 12 to disclose that the breathing air producer user facility includes a breathing air source and one or more air collection tanks, such as scuba tanks and

emergency air tanks, for providing a source of compressed human breathing air. The Banet patent is directed to a wireless diagnostic system for characterizing a vehicle's exhaust emissions, whereas Applicant's invention discloses a gas sample analysis system for use with compressed air in scuba and emergency air tanks. The Banet patent does not claim or describe an air collection tank, nor does the Banet patent describe compressed human breathing air as an element of that invention. The Examiner has not demonstrated that the Banet patent includes each and every element of the Applicant's invention arranged as in the Applicant's claim 12. Thus, the Examiner's rejection of claim 12 under 35 U.S.C. § 102(e) cannot be sustained.

Dependent claims 14 and 18-20 ultimately depend upon independent claim 12, and thus, incorporate by reference all of the elements and limitations of independent claim 12. 35 U.S.C. § 112, fourth paragraph. This includes the novel features disclosed in claim 12 of a breathing source and air sample, a breathing air analysis module, and one or more air collection tanks. As explained above, these elements of the present invention, as construed by reference to Applicant's specification, are not disclosed by the Banet reference. Therefore, the Examiner's rejection of claims 12, 14, and 18-20 under 35 U.S.C. § 102(e) cannot be sustained. Applicant respectfully requests that the Examiner withdraw this rejection and allow said claims.

III. REJECTION OF CLAIMS 1, 3, 5, 6, 8-12, 14 and 18-20 UNDER 35 U.S.C. § 103(a)

A. Claims 1, 3, 5, 6, 8-12, 14, and 18-20

Applicant respectfully traverses the Examiner's rejection of claims 1, 3, 5, 6, 8-12, 14, and 18-20 under 35 U.S.C. § 103(a) as being unpatentable over Sunshine, U.S. Patent

Application Publication No. 2003/021669, in view of Banet et al., U.S. Patent No. 6,604,033. Applicant has amended independent claims 1 and 12 to disclose that the user facility includes one or more sources of air and air collection tanks for providing a source of compressed human breathing air. Neither of the references describes a source of air or an air collection tank containing for collecting samples. The Sunshine application and Banet patent together do not suggest to one of ordinary skill in the art Applicant's claimed invention that includes an air source, a breathing air sample or a breathing air analysis module and remote certification, which are elements of the present invention disclosed in Applicant's independent claims. Applicant's invention saves valuable time in certifying air quality by eliminating the shipment of air samples from the user facility to the certification facility. Applicant reiterates Applicant's comments above concerning the Banet reference. The Sunshine reference does not suggest or teach the combination of Banet with Sunshine to make obvious Applicant's claimed invention. There is no teaching or suggestion of providing remote certification of breathing air sources that supply air for scuba tanks and emergency air tanks in the Sunshine reference.

B. CLAIMS 6, 8, 10 AND 19

Applicant respectfully traverses the Examiner's rejection of claims 6, 8, 10, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Banet et al., U.S. Patent No. 6,604,033. Applicant has amended independent claims 1 and 12 to disclose that the user facility includes one or more air collection tanks, such as scuba tanks and emergency air tanks, for providing a source of compressed human breathing air.

Dependent claims 6, 8, 10, and 19 ultimately depend upon independent claims 1

and 12, and thus, incorporate by reference all of the elements and limitations of those independent claims. 35 U.S.C. § 112, fourth paragraph. This includes the novel feature disclosed in amended claims 1 and 12 of at least one air source situated at a user facility for providing compressed human breathing air. As explained above, neither the air source of the currently amended claims 1 and 12 nor the breathing air sample and breathing air analysis module, as construed by reference to Applicant's specification, are disclosed by the Banet patent. Therefore, the Examiner's rejection of Applicant's claims 6, 8, 10, and 19 under 35 U.S.C. § 102(e) cannot be sustained. Applicant respectfully requests that the Examiner withdraw this rejection and allow said claims.

On page 4 of the current Office Action, the Examiner states, "Banet fails to teach a printer or printing results or explicitly teach testing for oil." The Examiner continues to explain that "[i]t would have been obvious to provide a printer and print the results in order to provide and maintain a hard copy independent of possible data corruption in a computer system as was known in the art." The Banet patent cited by the Examiner does not contain any suggestion to modify the invention described by that reference in the manner set forth by the Examiner. Herein, the Examiner has applied an "obvious to try" test to the Applicant's invention in determining whether said invention is obvious under 35 U.S.C. § 103(a).

Regarding the "obvious to try" test, the Court of Customs and Patent Appeals has previously stated:

[A]pplication of the "obvious to try" test would often deny patent protection to inventions growing out of well-planned research which is, of course, guided into those areas in which success is deemed most likely. These are, perhaps, the obvious areas to try. But resulting inventions are

not necessarily obvious. Serendipity is not a prerequisite to patentability. Our view is that “obvious to try” is not a sufficiently discriminatory test.

In re Lindell, 385 F.2d 453, 455 (C.C.P.A. 1967). Therefore, the Examiner’s assertion that the Applicant’s invention is obvious due to the Examiner’s own belief, in hindsight, that the Applicant’s use of “printing results” was obvious to try does not set forth a sufficiently discriminatory test upon which the Examiner may rely to reject the Applicant’s claims under 35 U.S.C. § 103(a). The Banet patent does not teach, disclose, or suggest the modification of a wireless diagnostic system for characterizing a vehicle’s exhaust emissions to include printing results as is claimed in claims 6, 8, and 19 of the present application.

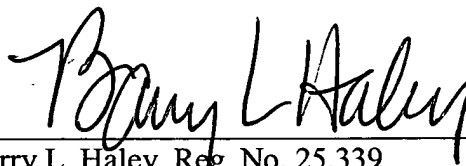
The Examiner also attempts to apply the aforementioned “obvious to try” test with respect to claim 10. The Examiner states that “[i]t would have been obvious to test for oil in order to determine if combusted or uncombusted oil is among the hydrocarbons emitted by an automobile because oil is a pollutant used in an automobile.” The Examiner’s assertion that the Applicant’s invention is obvious due to the Examiner’s own belief, in hindsight, that the Applicant’s use of “test[ing] for oil” in a breathing air sample, as described in Applicant’s claim 10, was obvious to try does not set forth a sufficiently discriminatory test upon which the Examiner may rely to reject the Applicant’s claims under 35 U.S.C. § 103(a). The Banet reference cited by the Examiner does not teach, disclose, or suggest the modification of a wireless diagnostic system for characterizing a vehicle’s exhaust emissions to include “test[ing] for oil” in a breathing air sample as is claimed in claim 10 of the present application.

In summary, Applicant’s claimed invention saves valuable time in certifying the

quality of air provided for an air source at a user facility that provides air commercially for scuba tanks and emergency tanks by eliminating the shipment of air samples from the air supplier user facility to the certification facility. This invention as claimed is not shown nor suggested to one of ordinary skill in the art by the prior art cited.

If there are any additional charges, including extension of time, please bill our Deposit Account No. 13-1130.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Barry L. Haley". The signature is written in a cursive, flowing style with a horizontal line underneath the name.

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